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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,616	09/17/2003	Nabil N. Ghaly		3523

7590  
Dr. Nabil N. Ghaly  
14 Longwood Drive  
South Huntington, NY 11746

EXAMINER
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RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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05/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/663,616

**Applicant(s)**

GHALY, NABIL N.

**Examiner**

ALEX P. RADA

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Preliminary Amendment*

In response to the preliminary amendment filed March 22, 2008 wherein applicant cancels claims 1-61, adds new claims 62-122 and claims 62-122 are pending in this application.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 62-122 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-68 of U.S. Patent No. 6,663,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-68 of the U.S. Patent No. 6,663,393 "anticipates" application serial number 10/663,616 of claims 62-122. Accordingly, the application of claims 62-122 are not patentably distinct from U.S. Patent No. 6,663,393 of claims 1-68. Here, U.S. Patent No. 6,663,393 of claims 1-68

requires elements of a means to generate a plurality of interactions for providing interactive effects with the user, a plurality of input control mechanisms for the user to interact with the device, memory means to store user's responses to said interactions, means to process said stored responses in order to generate knowledge information that includes normal responses to interactions, and which reflects the manner in which the user has responded to interactions, evaluation means to assess the user's response to the last interaction for classifying into one of a plurality of categories, wherein a first category corresponds to a normal response, and at least a second category corresponds to a response that is different from the normal response, and controlling means to select and initiate the next interaction based on the evaluated response to the last interaction while the application of claims 62-122 only requires elements of a means for generating a plurality of interactions for providing interactive effects with the user, a plurality, of input control mechanisms for the user to interact with the device, means for storing information related to user's responses to interactions, means for analyzing user's responses to derive knowledge information pertaining to how the user has interacted with the device, and means for controlling the device to operate in a distinctive manner that is different from the operation of a similar device with a different knowledge information. Thus it is apparent that the more specific U.S. Patent No. 6,663,393 of claims 1-68 encompasses the application of claims 62-122.

Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

3. Claims 62-122 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No.

11/294,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1-32 of the copending Application No. 11/294,803 "anticipates" application serial number 10/663,616 of claims 62-122. Accordingly, the application of claims 62-122 are not patentably distinct from copending Application No. 11/294,803 of claims 1-32. Here, copending Application No. 11/294,803 of claims 1-32 requires elements of a means for the device to generate a plurality of interactions for providing interactive effects with the user, a plurality of input control mechanisms for the user to interact with the device, memory means to store information related to user's responses to said interactions, means to analyze user's responses to said interactions in order to derive knowledge information pertaining to the user, including at least one of pattern of user's responses to interactions, user's preferences in responding to interactions, user's habits in interacting with the device, and personal information pertaining to the user, and control means to operate the device in a plurality of operating modes, wherein in a first operating mode the device stores, and analyzes user's responses to said interactions, and in a second operating mode the device employs said knowledge information to operate in a plurality of states while the application of claims 62-122 only requires elements of a means for generating a plurality of interactions for providing interactive effects with the user, a plurality, of input control mechanisms for the user to interact with the device, means for storing information related to user's responses to interactions, means for analyzing user's responses to derive knowledge information pertaining to how the user has interacted with the device, and means for controlling the device to operate in a distinctive manner that is different from the

operation of a similar device with a different knowledge information. Thus it is apparent that the more specific copending Application No. 11/294,803 of claims 1-32 encompasses the application of claims 62-122. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX P. RADA whose telephone number is (571)272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714

Robert E. Pezzuto  
Examiner  
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/A. P. R./  
Examiner, Art Unit 3714